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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,404	09/08/2005	Richard Ian Kitney	4586-4004	4625
27123	7590	02/11/2008		
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER RAMDHANIE, BOBBY	
			ART UNIT	PAPER NUMBER
			1797	
			NOTIFICATION DATE	DELIVERY MODE
			02/11/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/512,404	<b>Applicant(s)</b> KITNEY ET AL.	
	<b>Examiner</b> BOBBY RAMDHANIE	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 9-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I; Claims 1-8 in the reply filed on 01/24/08 is acknowledged.
2. The requirement is still deemed proper and is therefore made FINAL.

### ***Response to Arguments***

1. Applicant's arguments filed 01/24/08 have been fully considered but they are not persuasive. The following reasons are why:
2. Applicants state in their arguments that Roemer does not disclose nor suggest a container at all. Examiner respectfully disagrees. Dictionary.com states that a container is defined as anything that contains or can contain something. Examiner has given the claims their broadest reasonable interpretation, and not limiting its definition to just to the instant application. Roemer teaches that the volume coil is an assembly of a cylindrical form, and is supported by a non-magnetic, non-conducting and non-dielectric tube (Column 2 lines 33-35). Dictionary.com states that a tube is a hollow cylindrical body of metal, glass, rubber, or other material, used especially for conveying or containing liquids or gases. As a result, Examiner takes the position that the container of Roemer, anticipates the instant application. Furthermore, the tube of Roemer can be made "sealable" as well as be used to hold resected material. The adjective "sealable" does not make the container of the instant application sealed or having a top or bottom for that matter, just the potential for the container to be "sealed."

3. Applicants also state that the container of Ballon is just a standard open ended test tube, does not include a receiver coil, or a connector for detachably connecting the receive coil. Examiner respectfully disagrees. First, Applicants state that Ballon is just an open ended test tube. Applicants have themselves pointed out that this container is "sealable." Examiner also agrees with applicants that this test tube is "sealable" and therefore anticipates the instant application. Second, Examiner has used Figure 2a for referencing rejections. In this picture, Ballon clearly shows that the container is "sealable." Examiner would like to point out that Ballon states a Lucite cap is used to seal the tube (Page 755, second column, last four sentences). Thirdly, Applicants state that the container does not include the receiver coils. Claim 1 of the instant application does not recite the relationship of the coil with the container. Examiner takes the position, that Claim 1 of the instant application as written claims a container and a coil separately and is not integrated components.

4. Fourth, the configuration of the connector of the coil (whether it is either by a detachable connection or integrated direct connection) this connector would be inherent to the device. In the event that this connector is not explicitly taught, Examiner takes the position that one of ordinary skill in the art would have common knowledge of how to connect the coil by either connection.

### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5, 7, & 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Roemer et al (US4885539). Roemer et al teaches a sealable resection container (Claim 1) for containing resected material to be analyzed using magnetic resonance (Claim 1), the container including a receive coil for use in analyzing resected material contained in the container and a connector for detachable connecting the receive coil, directly or via an adaptor, to an input of a magnetic resonance scanner (Figure 4, Item numbers 44a and 44b & Column 6 lines 22-27).
3. For Claim 2, Roemer et al teaches a container according to Claim 1, wherein the connector provides an inductive coupling to the receive coil (Claim 1). Examiner takes the position that inductive coupling is the change in current flow through one device that induces current flow in the other device. The two devices may be physically contained in a single unit, or may be separated as in the antennae on the transmitter and the receiver or receive coil.
4. For Claim 3, Roemer et al teaches a container according to Claim 1, wherein the connector provides a direct electrical contact to the receive coil (Column 6 lines 9-27)
5. For Claim 5, Roemer et al teaches a container according to Claim 1, wherein the receive coil is also adapted for use as a transmit coil for use in analyzing material contained in the container (Claim 1 & Column 2 lines 32-39).

6. For Claim 7, Roemer et al teaches a container according to Claim 1, wherein the receive coil is constructed as a volume coil such that material to be analyzed can be placed inside the coil (Claims 1 & 2; Column 2 lines 32-39).

7. For Claim 8, Roemer et al teaches a container according to Claim 1, wherein the container is made of non-ferromagnetic material such that material contained in the container can be analyzed by use of an excitation pulse generated by use of at least one transmit coil external to the container (Claim 1 & 2, Column 2 lines 32-39).

8. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ballon et al. Regarding Claim 1, Ballon et al teaches a sealable resection container for containing resected material to be analyzed using magnetic resonance, the container including a receive coil for use in analyzing resected material contained in the container and a connector for detachably connecting the receive coil, directly or via an adaptor, to an input of a magnetic resonance scanner (Figure 2 and Page 755 2<sup>nd</sup> Column 1<sup>st</sup> Paragraph).

9. For Claim 6, Ballon et al teaches a container according to Claim 1 wherein the container is sealable (Figure 2a).

10. Claims 1-3, 5, 6, & 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Takamura et al (US5183045). Regarding Claim 1, Takamura et al teaches a sealable resection container for containing resected material to be analyzed using magnetic resonance (Abstract & Figures 1 a & b), the container including a receive coil for use in analyzing resected material contained in the container and a connector for detachably connecting the receive coil, directly or via an adaptor, to an input of a magnetic

resonance scanner (Abstract & Figures 1 a & b). Examiner takes the position that the connector would be inherent to the device.

11. For Claims 2 & 3, Takamura et al teaches that the connector provides inductive coupling as well as a direct electrical contact to the receive coil (Figure 1b). Examiner takes the position that inductive coupling occurs in the NMR measuring apparatus & that the direct electrical contact is seen in Figure 1b Item 8.

12. For Claim 5, Takamura et al teaches a container according to claim 1 wherein the receive coil is also adapted for use as a transmit coil for use in analyzing material contained in the container (Figure 1b).

13. For Claim 6, Takamura et al teaches a container according to claim 1 wherein the container is sealable (Figure 1b).

14. For Claim 8, Takamura et al teaches a container according to claim 1 wherein the container is made of non-ferromagnetic material such that material contained in the container can be analyzed by use of an excitation pulse generated by use of at least one transmit coil external to the container ((Column 3 lines 51-59).

### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roemer et al in view of Durrasse et al (EP0468857). Regarding Claim 2, Roemer et al teaches a container according to Claim 1. Roemer et al does not explicitly teach that the connector provides an inductive coupling to the receive coil. Durrasse et al teaches this feature. Durrasse et al teaches that the connector provides an inductive coupling to the receive coil (Page 1 of translation. 1<sup>st</sup> Paragraph). It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Roemer et al with Durrasse et al because according to Durrasse et al, this has the advantage of allowing one to examine a local area on the body or a specific zone inside the body of an animal, both of which could not be done with traditional cable connections (Page 2 of translation Top Paragraph).

18. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roemer et al in view of Leussler (US5245288). Regarding Claim 4, Roemer et al teaches all of the claim limitations of Claim 1. Roemer et al does not teach the connector includes a transmitter for establishing a wireless link between the receive coil and the input of the magnetic resonance scanner. Leussler teaches this feature. Leussler teaches the



connector includes a transmitter for establishing a wireless link between the receive coil and the input of the magnetic resonance scanner (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Roemer et al with Leussler because according to Leussler, disturbing effects are liable to occur when a coil system is connected to the processing unit via a cable and can be avoided by using a transmitter via a wireless link between the receive coil and the input of the magnetic resonance scanner (Abstract).

19. Alternatively, Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takamura et al in view of Leussler (US5245288). Regarding Claim 4, Takamura et al teaches all of the claim limitations of Claim 1. Takamura et al does not teach the connector includes a transmitter for establishing a wireless link between the receive coil and the input of the magnetic resonance scanner. Leussler teaches this feature. Leussler teaches the connector includes a transmitter for establishing a wireless link between the receive coil and the input of the magnetic resonance scanner (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Takamura et al with Leussler because according to Leussler, disturbing effects are liable to occur when a coil system is connected to the processing unit via a cable and can be avoided by using a transmitter via a wireless link between the receive coil and the input of the magnetic resonance scanner (Abstract).

20. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takamura et al. Regarding Claim 7, Takamura et al teaches a container according to claim 1. Takamura et al does not teach the receive coil is constructed as a volume coil such that

material to be analyzed can be placed inside the coil. Takamura et al teaches an obvious variant where the coil is placed on top of the resected material as well as having the resected material placed inside of the volume coil (Figure 9 Prior art; Figures 10 a & b). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Takamura et al to have the receive coil constructed as a volume coil because this would minimize signal noise that occurs from having the receive coil placed on one side of the resected material and is already of the prior art of record.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BOBBY RAMDHANIE whose telephone number is (571)270-3240. The examiner can normally be reached on Mon-Fri 8-5 (Alt Fri off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bobby Ramdhanie, Ph.D./  
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